

USSN: 09/932,523

Atty. Docket No.: 2001B078

Response dated December 14, 2004

Reply to Final OA mailed October 14, 2004

### REMARKS/ARGUMENTS

Claims 23-36 and 38-39 are pending in this Application. All pending claims were rejected in the Final Rejection. All claims remain in the form considered in the Final Rejection. Reconsideration of 23-36 and 38-39, in view of the following remarks, is respectfully requested.

#### Section 103 Rejections

Paragraphs 1-4 of the Final Rejection reject all claims over various rejections. The cornerstone of the rejections is a combination of U.S. Patent 5,883,199 to McCarthy, et al. in view of U.S. Patent 6,262,184 to Kanamori, et al. These references were applied in the previous Rejection dated May 4, 2004 to which a Response was filed July 28, 2004. The July 28, 2004 Response is referred to as further support for the arguments present in this current submission.

The current claims recite film structures, and labels produced from the films, including a polylactic acid combined with a toughening agent that may be a "polyurethane". The Final Rejection concludes that it would be obvious to substitute the polybutylenesuccinate toughening agent of McCarthy (disclosed in combination with a polylactic acid) with the "polyester carbonate" of Kanamori. The Final Rejection concludes the polyester carbonate incorporates urethane functionality and therefore is a "polyurethane" within the meaning of the current claims.

To conclude that the polyester carbonate material of Kanamori has urethane functionality, the Final Rejection relies upon Kanamori's disclosure at column 7, line 64 that a diisocyanate compound chain-extending agent may be used. Regardless of the nature of the compound produced using a diisocyanate compound chain extending agent, it is respectfully pointed out that use of the diisocyanate compound in Kanamori is for production of the "aliphatic polyester" (Component E) of Kanamori rather than the "polyester carbonate" (Component B) produced by Kanamori. Therefore, the Final Rejection's assertion that the "polyester carbonate" material of Kanamori includes urethane functionality because of the use of a diisocyanate compound is inaccurate. The Final Rejection correctly asserts that Kanamori discloses "succinic acid" and "1,4 butanediol" as possible reactants to produce the "polyester carbonate". See, column 5, lines

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8 and 16. The production of the "polyester carbonate" is disclosed at column 4, line 14 through line 49 of column 5. However, discussion of the use of the diisocyanate compound in Kanamori relates to production of the "aliphatic polyester (Component E). Production of the aliphatic polyester is disclosed at column 7, lines 23-67 of Kanamori.

For these reasons, all rejections fail since the rejections are based upon the premise that urethane functionality is incorporated into the "polyester carbonate" component of Kanamori. The Kanamori disclosure relied upon to create the urethane functionality is unrelated to the production the "polyester carbonate" compound as disclosed by Kanamori. For this reason alone, the Final Rejection fails to establish a *prima facie* case of obviousness.

Even if the Final Rejection is construed as asserting that it would be obvious to include the "aliphatic polyester" of Kanamori into the McCarthy combination as a "polyurethane" the rejections still fail for the reason that the aliphatic polyester compound of Kanamori is not a "polyurethane". The Final Rejection asserts that the urethane functionality is produced by polymerizing a diisocyanate compound with tartaric acid. This assertion is not fully understood. Conventionally, polyurethanes are produced reacting a glycol or alcohol with an isocyanate compound.

The column 7 Kanamori disclosure, relied upon in the Final Rejection, refers to the use of tartaric acid for producing side chain branching of the polyester. *See*, column 7, lines 39-54. *See* also U.S. Patent 6,703,115 disclosing the use of tartaric acid as a branching agent. Thus, Kanamori suggests selection of tartaric acid for polymerization with a diol when branching is desired. Of course, if tartaric acid is selected as the acid to produce the polyester, then succinic acid is not selected to produce the polyester. The current rejections rely upon the selection of succinic acid to produce the appropriate polyester (polybutylenesuccinate) for substitution in the McCarthy composition. Therefore, if tartaric acid is used to produce urethane functionality, the resulting polyester will not be polybutylenesuccinate. For this reason alone, the references fail to suggest inclusion of a polyurethane in the McCarthy composition.

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Finally, there is no indication in Kanamori that a polyurethane is produced by using a diisocyanate compound as a chain-extending agent. Indeed, Kanamori's disclosure suggests that a polyurethane is not produced. Conventional polyurethanes are known to lack biodegradability. The purpose of Kanamori's use of the polyester carbonate and aliphatic polyester is to introduce biodegradability into resin compositions. Therefore, production of a polyurethane is at odds with the basic principles disclosed by Kanamori.

For all of these reasons, reconsideration of the rejection of claims 23-36 and 38-39 is earnestly solicited.


### Conclusion

In the light of the foregoing, claims 23-36 and 38-39 are in condition for allowance. An early notice of allowance is respectfully requested.

Should any issues remain unresolved, the Examiner is encouraged to telephone the undersigned at the number indicated below so that all matters may be expeditiously resolved.

Respectfully submitted,

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